

REMARKS

The Office Action mailed October 20, 2006 ("Office Action") has been received. Claims 1-23 and 101 are pending in the present application. Claim 6 has been cancelled. Claims 1, 7, 10, 17 and 101 have been amended. No new claims have been added. All claim amendments and cancellations are made without prejudice or disclaimer and are not to be construed as a dedication to the public of any of the subject matter of the previously presented claims.

Claim Rejection Under 35 U.S.C. § 112

Claims 1-23 and 101 were rejected under 35 U.S.C. § 112, first paragraph, because the Office asserted that "the specification, while being enabling for linked rapamycin which are linked via attachment to a polymeric backbone, does not reasonably provide enablement for any rapamycin containing polymer drug delivery system or one in which a backbone is non-polymeric." Office Action, p. 2. While Applicants respectfully disagree with the Office's assertion with respect to enablement and believe that the specification is enabling for the rejected claims, in the interest of advancing prosecution, claim 1 has been amended to recite, "wherein the molecules are linked via attachment to a backbone comprising polymers." This amendment is made without disclaimer or prejudice to Applicants' right to pursue the rejected claims in a continuation application.

It is respectfully submitted that currently amended claim 1, and claims 2-23 and 101 depending therefrom, are consistent with the Office's view of enabled subject matter as expressed in the Office Action. Accordingly, Applicants respectfully solicit withdrawal of the rejection of claims 1-23 and 101 under 35 U.S.C. § 112, first paragraph.

Claim Rejection Under 35 U.S.C. § 102

Claims 1-4 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated U.S. Patent No. 6,726,923 issued to Iyer, et al., ("*Iyer*"). Applicants respectfully traverse the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); *see also* MPEP 2131. "The identical

invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

Because the Office did not include claim 6 in its anticipation rejection based on *Iyer*, it is understood that the Office considers claim 6 to be patentable over *Iyer*. Claim 1 has been amended herein to include the limitations that were recited in claim 6. Claim 6 has been canceled. Accordingly, it is believed that independent claim 1, as amended, as well as claims 2-4 depending therefrom, will be considered patentable over *Iyer* by the Office. Withdrawal of the rejection of claims 1-4 under 35 U.S.C. § 102 based on *Iyer* is therefore respectfully solicited. The claim amendments herein are made without disclaimer or prejudice to Applicants’ right to pursue the rejected claims in a continuation application.

Double Patenting

Claims 1-23 and 101 were provisionally rejected on the ground of nonstatutory obviouness-type double patenting as allegedly being unpatentable over claims 1-52 of copending Application No. 11/517,205 (US ’205). In addition, claims 1-23 and 101 were provisionally rejected on the ground of nonstatutory obviouness-type double patenting as allegedly being unpatentable over claims 1-23 and 101 of copending Application No. 11/517,207 (US ’207).

Applicants believe that no response to the provisional double patenting rejections is required unless and until a patent issues from the present application or the cited copending applications (US ’205 and US ’207).

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw all outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

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Respectfully submitted,

By 

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